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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,575	08/06/2002	Sydney Gordon Low	DAVI147.001APC	1720
20995 7590 01/03/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER CORRIELUS, JEAN M	
			ART UNIT 2162	PAPER NUMBER
			NOTIFICATION DATE 01/03/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/009,575

Applicant(s)

LOW ET AL.

Examiner

Jean M. Corrielus

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed October 2, 2007 have been fully considered but they are not persuasive. (See examiner remark section).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
4. Claims 19-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olivier US Patent no. 6,480,885 and Ogilvie et al., (hereinafter "Ogilvie") US Patent no. 6,324,569.  
As to claim 19, Olivier discloses an analogous system that enables users to exchange group electronic mail by establishing profiles and criteria for determining personalized subsets within a group by comparing the identified appearing on the allowed list to determine whether each

designated recipient is on the list for the intended recipient that stored on the database of the e-mail manager (col.17, lines 7-12). In particular, Olivier stated that if the message is not approved, the sender is notified by the system (col.14, line 56-col.15, line 15). Although, Olivier does not explicitly disclose the use of notifying the recipient if a message is unapproved.

Olivier, however, stated when someone responds to a message via their email client's reply all feature, the message is addressed back to that to header field, including the encoded unique ID is extracted from the email address and it then uses the stored distribution list associated with the unique ID, rather than the sender's distribution list, so the system would automatically checking the recipient's message acceptance and unapproval criteria data. Olivier also allows the sender to modify the setting when sending a message. Such teaching of Olivier has the functional limitation of sending a notification to the recipient when a message is unapproved with respect to the message criteria data set by the sender. Once the notification is set by Olivier in the message criteria data, the recipient will automatically receives an acknowledgement as to whether a message is approved or not (see Olivier col.16, lines 25-62). Ogilvie, on the other hand, discloses an analogous system for "notifying the recipient if a message is unapproved" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39). The system of Ogilvie has the capability, both, of not requiring that recipients affirmatively remove unwanted email or create a reply message having remove in the subject to indicate their lack of interest in the subject matter (col.11, lines 1-6) and determining whether they contain any self removing message indicators from message originators then automatically notifying the recipient according to the instruction

of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references, wherein the message distribution provided therein (See Olivier's fig.10 (2)) would incorporate the use of notifying the recipient if the message is unapproved (unsolicited), in the same conventional manner as disclosed by Ogilvie (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39). One having ordinary skill in the art would have been motivated to utilize such a combination would provide Olivier's system the enhanced capability of managing unsolicited email messages without the messages inadvertently removed by a message filter, thereby reducing the inconvenience of unsolicited email by making it possible for officials to present messages that do not have to be manually removed by the recipient.

As claim 20, Olivier and Ogilvie disclose substantially the invention as claimed. In addition Ogilvie discloses the claimed "allowing the recipient to view an unapproved message" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39).

As to claim 21, Olivier and Ogilvie disclose substantially the invention as claimed. Olivier, however does not explicitly disclose the claimed notifying the recipient with a notification message having a link to network data representing a list of unapproved. Ogilvie, on the other hand, discloses an analogous system for providing email message originator and distributors with

default control over message removal at a message recipient's location, regardless of whether the message has been opened. In particular, Ogilvie discloses the claimed feature "notifying the recipient if a message is unapproved" as a means of providing the recipient with the capability to manage unsolicited email messages without the messages inadvertently removed by a message filter, and also requesting to remove from the mailing list (col.1, lines 55-64; col.14, lines 26-39). Ogilvie, also transfers the burden from the recipient to the system by automatically removing unsolicited email message before or after being displayed. The system of Ogilvie has the capability, both, of not requiring that recipients affirmatively remove unwanted email or create a reply message having remove in the subject to indicate their lack of interest in the subject matter (col.11, lines 1-6) and determining whether they contain any self removing message indicators from message originators then automatically notifying the recipient according to the instruction of the replacement message (col.13, lines 1-5; col.14, lines 28-39). Therefore, it would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to combine the teachings of the cited references, wherein the message distribution provided therein (See Olivier's fig.10(2)) would incorporate the use of notifying the recipient if the message is unapproved (unsolicited), in the same conventional manner as disclosed by Ogilvie (col.1, lines 55-64; col.13, lines 1-5; col.14, lines 28-39). One having ordinary skill in the art would have been motivated to utilize such a combination would provide Olivier's system the enhanced capability of managing unsolicited email messages without the messages inadvertently removed by a message filter, thereby reducing the inconvenience of unsolicited email by making it possible for officials to present messages that do not have to be manually removed by the recipient.

As to claim 22, Since Olivier discloses a web browser plug-ins and other new technology that allow the exchanged messages to be stored somewhere other than the currently viewed web site, retrieve messages from the independent data store and displayed to the user and use an address of a specific page being viewed within the web site (col.25, lines 25-41), the claimed wherein the network data comprises markup language data accessible by a computer device of the recipient is met.

As to claim 23, Olivier discloses the claimed allowing the recipient to set criteria to determine if the message is approved (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 24, Olivier discloses the claimed wherein the criteria include a sender of the message being on a stored approved list for the recipient (col.14, line 55-col.16, line 15; col.17, lines 7-21).

As to claim 25, Olivier discloses the claimed allowing the recipient to change the criteria (col.17, line 65-col.18, line 4).

As to claims 26-27, Olivier discloses the claimed notifying a sender of the unapproved message of deletion of the unapproved message (col.14, lines 56-58; col.15, lines 4-14).

As to claim 28, Olivier discloses the claimed wherein the message and the criteria are stored on an electronic message server (col.5, lines 5-45).

As to claims 29-32:

Claims 29-32 are computer system performing by the method of claims 19-28 above. They are, therefore, under the same rationale. In addition, Ogilvie discloses the use of storing and sending a notification to the recipient of unapproved message (col.1, lines 46-53); an access server for generating a display page with a list of unapproved message (col.5, lines 6-45); wherein the list of unapproved messages includes links to the unapproved message respectively and which on selection causes transmission of an unapproved message to a recipient's computer device for viewing by the recipient" (col.1, lines 55-65; col.14, line 26-38).

As to claim 33, Olivier discloses the claimed wherein the criteria include the sender of a message being on an approved list for the recipient stored on the system (col.14, line 55-col.15, line 15).

As to claims 34-35, Olivier discloses the claimed wherein the display page includes a link to at least one display page for displaying and changing the criteria ((col.17, line 65-col.18, line 4).

***Remark***

5. Applicant asserted that neither Olivier nor Ogilvie teaches or suggests the claimed "notifying the recipient if the message is unapproved". The examiner has carefully considered the subject matter on the response, the rejections advanced by the examiner, and the evidence of obviousness relied upon by examiner as support for the rejections. In rejecting the claims under



35 U.S.C. 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason has stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. The examiner's position with respect to the assertion above is that Ogilvie discloses an email verification system for notifying the recipient if message is approved (col.14, lines 26-39). The system disclosed by Ogilvie checks the incoming messages to determine whether they contains a self-removing messaging indicator from the message originator or message distributors and automatically notifies the recipient , wherein the recipient would be automatically notified. Similarly to the description provided by the specification, page , wherein the specification states that the e-mail message is based on whether the sender of the message is on a list of approved senders for the intended recipient that is stored on the database of the e-mail manager. Therefore, removal code of Ogilvie determines whether the incoming messages contain any self-removing message indicators from message originators and/or message distributors (intended recipient list). Ogilvie also states that the check triggering criteria used by the intended recipient list allows the option to block the email or send the recipient a notification request, see col.13, lines 62-col.14, line 12). The aforementioned assertion is moot.

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

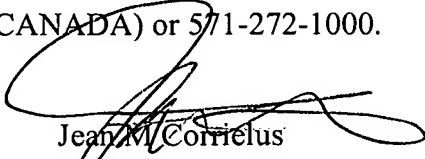
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Jean M. Corielus  
Primary Examiner  
Art Unit 2162

December 26, 2007